

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

US000403

Application Number

09/746,045

Filed

22 Dec 2000

First Named Inventor

Antonio J. Colmenarez

Art Unit

2629

Examiner

Shapiro, Leonid

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

Five (5) pages are attached

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

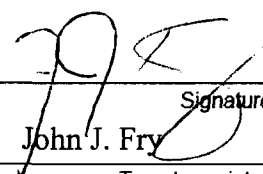
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Registration number _____

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____


Signature
John J. Fry
Typed or printed name

Typed or printed name

1.440.391.5100

Telephone number

25 Aug 2006

Date

Please direct all communications to Yan Glickberg, Esq., Philips Intellectual Property & Standards, P.O. Box 3001, Briarcliff Manor, NY 10510, Phone: 1.914.333.9618.

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

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*Total of _____ forms are submitted.

Summary

Applicant requests a review of the legal and factual bases for the rejections in the present application. As more fully set forth below, it is submitted that the Final Rejection fails to establish a *prima facie* case of obviousness:

- Claims 1-29
 - The Final Rejection relies on Livits as teaching changing a feature on a display in correspondence with a movement of the handheld device.
 - Livits does not teach the required claim limitation.
- Claims 1-22
 - Claim 1 requires that a control unit detect the position of a handheld device relative to a position of a user of the moveable handheld device.
 - The Final Rejection does not allege that the cited references teach the required claim limitation. The missing limitation is not otherwise taught by the cited references.
- Claim 28
 - The Final Rejection relies on Bowling as teaching a control unit which detects the handheld device relative to the position of the handheld device.
 - Bowling does not teach the required claim limitation.
 - As Bowling is directed to a safety feature for a stump cutter, the Final Rejection also fails to establish a proper motivation for combining the cited references.

Claims 1-29

The Advisory Action and Final Rejection

The Response to Argument section of the Final Rejection construes Applicant's argument as stating that Livits' movable housing has only two positions, and as relying on the fact that Livits provides only limited movement of the housing relative to the user's body. The Final Rejection then concludes that the independent claims do not specifically relate "to the number of positions of movable housing relative to the user."¹

¹ This continuation page of the Advisory Action merely restates the above position. It does not address the matters set out in Applicant's Request for Reconsideration.

The Advisory Action and the Final Rejection misconstrue the present claims, applicant's position, and the teachings of Livits.

The Livits Reference

Livits is directed to a computer input device that can be used as a keyboard or a pointing device. The keyboard includes multi-function keys. When used as a keyboard, a housing is mounted for rocking movements relative to a working support surface (*e.g.*, a desk) or a stationary base. The housing is thus rocked between three stable positions so as to vary the function of the multi-function keys.²

In rejecting the present claims, the Final Rejection relies on Livits col. 3:18-23,³ which states as follows:

In order to achieve the above objects, as well as others which will become apparent hereafter, a single hand controlled input device comprises a movable housing having remote and proximate portions relative to the position of the user of the input device.

Thus, the cited portion of Livits simply teaches that one part of the housing is relatively remote or farther from the user, while another part of the housing is relatively proximate or nearer to the user.

As shown in Livits Figure 1, the proximate portion 14 is a hand supporting surface. The remote portion 18 includes a keyboard 24 and trackball 30. The user operates the device by placing his or her hand on the hand supporting surface and rocking the device between the three positions relative to the support surface or its stationary base. Doing so varies the functions of the multi-function keys.⁴

² See Livits at Abstract.

³ See Final Rejection at pages 3, 11, 13, and 15.

⁴ See, *e.g.*, Livits at col. 3:23-28; col. 3:32-36; col. 5:13-25.

Present Claims 1-29

The present application includes four (4) independent claims: claims 1, 23, 28, and 29. Independent **claim 1** requires, in pertinent part, that

the control unit detects the position of the handheld device relative to a position of a user of the movable hand-held device in at least two-dimensions from the image data from the at least one light detector and translates the position to control a feature on a display, wherein a change in said feature corresponds to a movement of the movable handheld device relative to the user.

(emphasis added). Independent claims **23**, **28**, and **29** include a similar limitation.

The Final Rejection correctly notes that the underlined limitation is not satisfied by Girod, either alone or in combination with Rice, Bowling, or McTernan. The Final Rejection cites Livits column 3:18-23 (quoted above) to remedy this deficiency.

As discussed above, however, Livits merely discloses a housing having a first portion which is nearer to the user and second portion which is farther from the user. Moreover, Livits simply discloses varying a function of the device based on its position relative to a support surface or stationary base.

Livits thus does not disclose detecting the position of its housing portions -- or any other portions of the device -- relative to a position of the user. Consequently, Livits does not disclose or suggest changing a feature on a display in correspondence with a movement of the handheld device relative to the user as required by the present claims.

As the cited references fail to disclose or suggest each and every feature of the present claims, the Final Rejection fails to establish a *prima facie* case of obviousness.⁵ In view of the above, the Final Rejection's reliance on *Keller*, *Merck*, and *Van Guens* is also misplaced.

⁵ MPEP 2142.

Claims 1-22

Claim 1 stands rejected as obvious over Girod in view of Livits. Page 2 of the Final Rejection alleges that Girod teaches a control unit which

detects [the] position of the hand-held device (See Fig. 2, item 206, col. 4, Lines 30-40) in at least two dimensions . . .

However, the rejection of claim 1 does not allege that Girod's control unit detects the position of the hand-held device relative to a position of the user of the hand held device as is specifically recited by the claim. In fact, the Final Rejection concedes that Girod does not disclose this limitation.⁶ Having failed to even allege that the references cited in connection with claim 1 teach the limitation, the Final Rejection fails to establish a *prima facie* case of obviousness.⁷ Moreover, the failure to so allege places Applicant in the untenable position of having to surmise the reasons, if any, for the rejection.

Claim 28

The Final Rejection

Independent claim 28 stands rejected as obvious over Girod in view of Bowling and Livits. Claim 28 requires that the control unit detect the position of the handheld device relative to the position of a user carrying the hand-held device. The Final Rejection concedes that Girod fails to teach this limitation and cites Bowling in an attempt to remedy the deficiency.⁸

The Bowling Reference

Bowling is directed to a safety feature for a stump cutter 10. An operator's station 30 contains a number of buttons or switches which allow the user to operate the stump cutter 10 from a remote location.⁹ A monitoring system determines the position of the operator's station 30 relative to the stump cutter 10. Depending on the distance between

⁶ Final Rejection page 13.

⁷ MPEP 2142

⁸ Final Rejection page 13.

⁹ Bowling col. 3:65 to col. 4:3; Figure 6.

the operator's station 30 and the stump cutter 10, the cutter 10 is shut down.¹⁰ In one embodiment, Bowling discusses a system which monitors the positions of multiple users relative to the stump cutter 10. If a user gets too close, the cutter 10 is shut down.¹¹

To support the rejection of claim 28, the Final Rejection cites Bowling col. 14:65 to col. 15:4

A wireless remote control system as recited in claim 1, further including at least one miniature operator's station having a first wireless communication link for use by additional personnel working about said stump cutter wherein said control system interface via said second wireless communication link detects and monitors the position of users about said stump cutter.

Present Claim 28

Claim 28 requires monitoring the position of a hand held device relative to the position of a user carrying the handheld device.

As discussed above, Bowling teaches a system which monitors the positions of one or more users relative to a stump cutter. Bowling does not teach monitoring the position of a handheld device relative to a user carrying the handheld device. Because the references fail to disclose or suggest each and every feature of the claim, it is submitted that the Final Rejection fails to establish a *prima facie* case of obviousness with respect to claim 28.¹²

Conclusion

For at least the foregoing reasons, it is submitted that pending claims 1-29 distinguish patentably and non-obviously over the prior art of record. Applicant requests a finding that the application is allowable on the existing claims and that prosecution remain closed.

¹⁰ Bowling col. 4:38-46.

¹¹ Bowling col. 11:16-32.

¹² MPEP 2142.

OF
25 Aug 2006